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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PARRY, CHRISTOPHER L

ART UNIT

PAPER NUMBER

2421

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/631,540	<b>Applicant(s)</b> IMANAKA, RYOICHI	
	<b>Examiner</b> CHRIS PARRY	<b>Art Unit</b> 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 October 2009 has been entered.

### ***Reissue Applications***

2. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,790,172 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

***Response to Arguments***

3. Applicant's arguments with respect to claims 25-27 have been considered but are moot in view of the new ground(s) of rejection.

***Oath/Declaration***

4. The reissue oath/declaration filed 19 March 2002 with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The reissue declaration fails to specifically identify at least one error as just merely listing a claim as an error is insufficient. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. See MPEP § 1414 II(C).

***Claim Rejections - 35 USC § 251***

5. Claims 25-27 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lett et al. "Lett" (USPN 5,592,551) in view of Durden et al. "Durden" (USPN 5,003,384) and further in view of Horton et al. "Horton" (USPN 4,945,563).

Regarding Claim 25, Lett discloses a subscriber apparatus (subscriber terminal 14 – figs. 1-3) for receiving an output signal outputted from a server apparatus (10/12 – figs. 1-2) (Col. 7, lines 20-37), said subscriber apparatus comprising:

a receiving unit (124 – fig. 3) which is capable of receiving a subscriber's request (i.e., subscriber makes selections using remote control 126) for a) providing audio/video information to be recorded (i.e., when a user selects a pay-per-view event, the user can select to purchase and record the event by outputting the signal to VCR 18), and b) providing the audio/video information to be displayed without recording the audio/video information (i.e., when a user selects a pay-per-view event, the user can select to purchase and watch the event by outputting the signal to TV 20) (see figs. 3 & 9; Col. 9, lines 1-42 and Col. 14, lines 38-67);

a transmitter (154 – fig. 3) for transmitting an information signal according to the subscriber's request to said server apparatus (i.e., RF-IPPV module 154 transmits the

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subscriber's authorization requests for PPV events and data stored associated with the purchase of the PPV events to system manager 22) (Col. 10, lines 49-67);

wherein charge amount for providing the audio/video information is decided if the information signal indicates that the subscriber's request is to display the audio/video information (i.e., system manager 22 receives the data associated with the purchase of events from the subscriber terminal 14 and transmits an authorization signal back to the subscriber terminal 14) (Col. 4, line 41 to Col. 5, line 4 and Col. 10, lines 52-60).

Lett discloses subscriber terminal 14 receives authorization data from system manager 22, however Lett fails to disclose whether the authorization data includes an indication of whether the user is recording or displaying without recording the audio/video information.

In an analogous art, Durden discloses a subscriber apparatus (subscriber terminal 15 – fig. 1) for receiving an output signal outputted from a server apparatus (8/10 – fig. 1) (Col. 6, line 43 to Col. 7, line 4), said subscriber apparatus comprising:

a receiving unit which is capable of receiving a subscriber's request (i.e., subscriber makes selections using a remote control) for a) providing audio/video information to be recorded (i.e., when a user selects a PPV event, the user can select to purchase and record the event by selecting the “Pre-Buy” option), and b) providing the audio/video information to be displayed without recording the audio/video information (i.e., when a user selects a PPV event, the user can select to purchase and watch the event by selecting the “Buy” option) (see figs. 3 & 9; Col. 9, lines 1-42 & Col. 14, lines 38-67);

a transmitter (20 – fig. 1) for transmitting an information signal according to the subscriber's request to said server apparatus (i.e., IPPV module 20 transmits the subscriber's authorization requests for PPV events and data stored associated with the purchase of the PPV events to system manager 8) (Col. 10, lines 49-67);

wherein a first charge amount for providing the audio/video information is decided if the information signal indicates that the subscriber's request is to record the audio/video information (i.e., in response to the "Pre-Buy" request, system manager 8 sends authorization data or "information signal" and upon receipt of the authorization data and confirmation of the event purchase, the user is charged for the "Pre-Buy") (fig. 3; Col. 11, line 57 to Col. 12, line 14 and Col. 12, lines 24-35 & lines 56-66); and

wherein a second charge amount for providing the audio/video information is decided if the information signal indicates that the subscriber's request is to display the audio/video information without recording the audio/video information (i.e., in response to the "Buy" request, system manager 8 sends authorization data or "information signal" and upon receipt of the authorization data and confirmation of the event purchase, the user is charged for the "Buy" and the program is descrambled for viewing) (fig. 3; Col. 5, lines 9-11; Col. 11, line 57 to Col. 12, line 14 and Col. 12, lines 24-35 & lines 56-66).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lett to include wherein a charge amount for providing the audio/video information is decided if the information signal indicates that the subscriber's request is to record or display the audio/video information as taught by

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Durden for the benefit of increasing control and enhancing the diversity of an impulse pay-per-view system.

Although the combination of Lett and Durden disclose allowing a user to display or record audio/video information and charging the subscriber an amount for displaying or recording audio/video information, the combination is silent on a second charge amount different that the first charge amount for displaying the audio/video information without recording the audio/video information.

In an analogous art, Horton discloses a viewer may request audio/video information, such as a first run movie, and depending upon a selected viewing mode, the selected audio/video information may be viewed and the viewer would pay a first fee or the viewer could choose to view and record the audio/video information for a second higher fee (Col. 2, lines 56-65 and Col. 3, lines 39-53). Horton teaches it is well known in the art for a cable or satellite provider to charge a viewer different amounts depending upon whether the viewer has selected to merely display the audio/video information without recording the audio/video information or has selected to create a copy of the audio/video information by recording it for later or repeated viewing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lett and Durden to include a second charge amount different that the first charge amount for displaying the audio/video information without recording the audio/video information as taught by Horton for the benefit of combining prior art elements according to known methods to yield predictable results of charging a second higher fee that includes a charge related to the purchase of a cassette of the program



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while preventing the viewer from making pirated copies of the recorded program (Horton: Col. 2, line 63 to Col. 3, line 3).

As for Claim 26, Lett, Durden, and Horton disclose, in particular Lett teaches wherein the subscriber's request indicates whether the audio/video information is recorded into a recording medium or the audio/video information is displayed on a display terminal without recording the audio/video information (i.e., using the menu provided in figure 9, the subscriber selects whether to purchase the pay-per-view event without recording the output signal or to record the pay-per-view event into a recording medium such as cassette tape in VCR 18) (Col. 14, lines 38-67; Col. 10, lines 52-60; and Col. 9, lines 1-15).

As for Claim 27, Lett, Durden, and Horton disclose, in particular Lett teaches a server apparatus [10/12] used with the subscriber apparatus [14] according to claim 25, wherein said server apparatus [10/12] decides the charging amount for providing the audio/video information based on the information from said transmitter (i.e., system manager 22 generates billing information for the subscriber based on data received from the subscriber terminal associated with pay-per-view event purchases) (Col. 4, line 41 to Col. 5, line 4 and Col. 10, lines 52-60).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS PARRY whose telephone number is (571) 272-8328. The examiner can normally be reached on Monday through Friday, 8:00 AM EST to 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN MILLER can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/  
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